

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-4 are pending in this application. Claims 1 and 3 are independent and hereby amended. No new matter has been added. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

II. SUPPORT FOR AMENDMENT IN SPECIFICATION

Support for this amendment is provided throughout the Specification as originally filed and specifically at paragraphs [0031], [0044] and Fig. 1 of Applicant's corresponding published application. By way of example and not limitation:

[0031]The first lens GR1 is composed of a negative lens, a reflection mirror M for bending or folding the optical axis by 90.degree., and a positive lens having non-spherical surfaces at the both surface sides thereof. The second lens group GR2 is composed of a negative lens, and a connection lens of a negative lens and a positive lens. **The third lens group GR3 is comprised of a positive lens having non-spherical surfaces at the both surface sides thereof.** The fourth lens group GR4 is comprised of

a connection lens of a positive lens and having non-spherical surface at the object side, and a negative lens. The fifth lens group GR5 is composed of a connection lens of a negative lens and a positive lens, and a positive lens. The positions of the first lens group GR1, the third lens group GR3, the fifth lens group GR5 and the low-pass filter LPF are fixed at zooming operation. Moreover, **the third lens group includes an iris as a light quantity adjustment member ST1 at the image surface side. The light quantity adjustment member ST1 also has a function as an aperture limiting member.**

[0044]Moreover, in both the zoom lenses of the first and third embodiments, **since the light quantity adjustment member ST1 included within the third lens group is fixed, complicated mirror cylindrical configuration is not required so that compact and thin structure can be realized.**

FIG. 1A

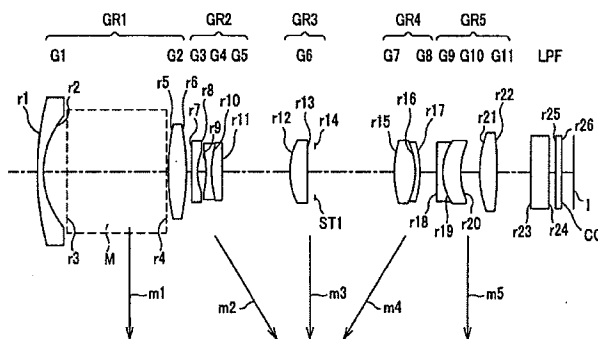
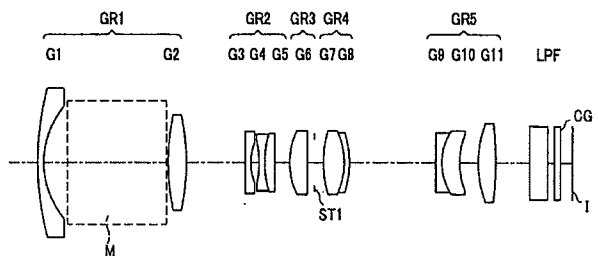


FIG. 1B



III. RESPONSE TO CLAIM OBJECTIONS

Claims 1 and 3 are hereby amended, thereby obviating the objections.

IV. RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-4 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 7,436,599 to Mihara (hereinafter, merely "Mihara'599") in view of U.S. Patent No. 7,301,710 to Nishioka (hereinafter, merely "Nishioka").

Claims 1-4 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,754,446 to Hagimori et al. (hereinafter, merely "Hagimori") in view of Mihara'599.

Claim 1 recites, *inter alia*:

...a third group including a positive lens having non-spherical surfaces at both surface sides thereof, and a light quantity adjustment member at the image surface side, the light quantity adjustment member being fixed during magnification changing operation... (Emphasis added)

Applicant submits that neither Mihara'599 nor Nishioka nor Hagimori, taken alone or in combination, would disclose or render predictable the above identified features of claim 1. Specifically, none of the references used as a basis for rejection disclose or render predictable **"a third group including a positive lens having non-spherical surfaces at both surface sides thereof, and a light quantity adjustment member at the image surface side, the light quantity adjustment member being fixed during magnification changing operation,"** as recited in claim 1.

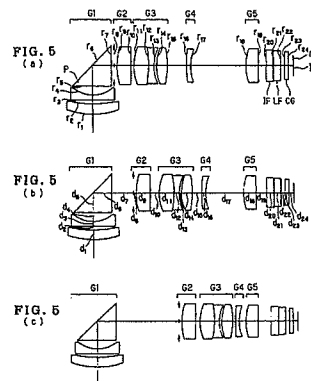
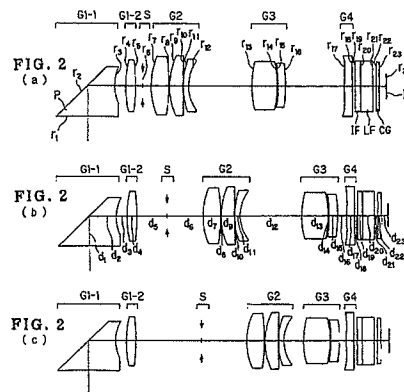
i) The Office Action (see page 3) asserts that Mihara'599 discloses a light quality adjusting member, and refers to Fig. 5, example 5, the aperture stop. Thus, Mihara'599, col. 12, lines 32-51, col. 13, lines 36-45, Figs. 2 and 5 are reproduced as follow:

Mihara'599, col. 12, lines 32-51:

As shown in FIG. 2, Example 2 is directed to an optical path-bending zoom optical system made up of a 1-1st lens group consisting of an optical path bending prism P equivalent to a double-concave negative lens, a 1-2nd lens group consisting of a double-convex positive lens, **an independently moving aperture stop S**, a second lens group G2 consisting of a double-convex positive lens, a positive meniscus lens convex on its object side and a negative meniscus lens convex on its object side, a third lens group G3 consisting of a double-convex positive lens and a negative meniscus lens convex on its image side, and a fourth lens group G4 consisting of a positive meniscus lens convex on its object side. For zooming from the wide-angle end to the telephoto end of the zoom optical system, the second lens group G2 and the third lens group move toward the object side while the spacing between them becomes wide. **The aperture stop S located between the 1-2nd lens group 1-2 and the second lens group G2, too, moves toward the object side while the spacing between the 1-2nd lens group G1-2 and the fourth lens group G4 becomes narrow.**

Mihara'599, col. 13, lines 36-45:

As shown in FIG. 5, Example 5 is directed to an optical path-bending zoom optical system made up of a first lens group G1 consisting of a positive meniscus lens convex on its object side, a negative meniscus lens convex on its object side and an optical path bending prism P equivalent to a plane-parallel plate, **a second lens group G2 consisting of an aperture stop and a double-convex positive lens**, a third lens group G3 consisting of a doublet consisting of a double-convex positive lens and a double-concave negative lens and a double-convex positive lens ...



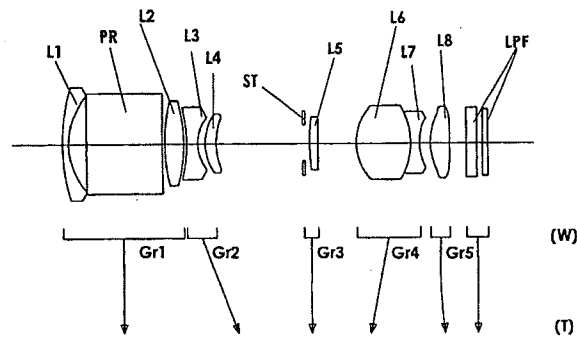
Applicant submits that in Mihara'599, the **independently moving aperture stop S moves toward the object side** while the spacing between the 1-2nd lens group G1-2 and the fourth lens group G4 becomes narrow. In other words, the independently moving aperture stop in Mihara'599 is **NOT fixed** during magnification changing operation. Thus, Mihara'599 fails to disclose or render predictable "a third group including a positive lens having non-spherical surfaces at both surface sides thereof, and a light quantity adjustment member at the image surface side, the light quantity adjustment member being fixed during magnification changing operation," as recited in claim 1.

ii) The Office Action (see pages 5-6) asserts that Hagimori discloses a light quality adjusting member, and refers to Hagimori, Fig. 3, example 3, the aperture stop, and col. 5, line 49-col. 6, line 4, which are reproduced as follow:

Hagimori, col. 5, line 49-col. 6, line 4:

The zoom lens system included in the imaging device according to the third embodiment shown in FIG. 3 comprises from the object side: a first lens unit Gr1 having positive optical power and being stationary with respect to the image surface during zooming; a second lens unit Gr2 having negative optical power and moving from the object side to the image side with respect to the image surface during zooming from the shortest focal length condition to the longest focal length condition; **a diaphragm ST**; a third lens unit Gr3 having positive optical power and being stationary with respect to the image surface during zooming; a fourth lens unit Gr4 having positive optical power and moving from the image side to the object side with respect to the image surface during zooming from the shortest focal length condition to the longest focal length condition; and a fifth lens unit Gr5 having negative optical power and being stationary with respect to the image surface during zooming. Of these, the first lens unit Gr1 comprises from the object side: a first lens element L1 having a negative meniscus configuration convex to the object side; a right-angle prism PR expressed as a parallel plate in the figure; and a second lens

element L2 having a bi-convex configuration. The fifth lens unit Gr5 comprises only a lens element L8 having a positive meniscus configuration convex to the object side.



Applicant submits that Hagimori describes a diaphragm ST, but fails to disclose or render predictable **“a third group including a positive lens having non-spherical surfaces at both surface sides thereof, and a light quantity adjustment member at the image surface side, the light quantity adjustment member being fixed during magnification changing operation,”** as recited in claim 1.

Furthermore, this deficiency of Mihara’599 and Hagimori is not cured by the supplemental teaching of Nishioka.

Therefore, Applicant submits that independent claim 1 is patentable and respectfully request reconsideration and withdrawal of the rejection.

For reasons similar to, or somewhat similar to, those described above with regard to independent claim 1, independent claim 3 is also patentable, and Applicant thus respectfully requests reconsideration of the rejections thereto.

V. DEPENDENT CLAIMS

The other claims in this application are each dependent from one of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Applicant thereby respectfully requests reconsideration and withdrawal of rejections thereto. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Because Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the Office Action. This should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

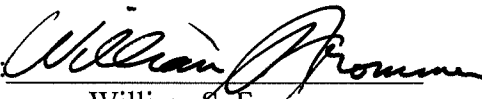
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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